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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,203	02/23/2004	Dylan Van Atta	2242-67334	8831

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KLARQUIST SPARKMAN, LLP  
121 SW SALMON STREET  
SUITE 1600  
PORTLAND, OR 97204

EXAMINER
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MORAN, KATHERINE M

ART UNIT	PAPER NUMBER
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3765

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/785,203

Applicant(s)

ATTA ET AL.

Examiner

Katherine Moran

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-19, 33-39, 44-47 and 54-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 36 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's reply of 4/17/06 has been received and reviewed. Applicant amended claims 15, 17, 18, 44, 46, 47, and added new claims 54-58. Claims 1-12, 20-32, 40-43 and 48-53 were cancelled, with claims 13-19, 33-39, 44-47, and 54-58 are pending.

The indicated allowability of claims 13, 14, 33-39, 44, and 45 is withdrawn in view of the newly discovered reference to Chen-Lieh (U.S. 6,341,863) and reconsideration of the prior art of record. Revised prior art rejections follow. Accordingly, the finality of the last office action is withdrawn.

### ***Claim Objections***

1. Claim 18 is objected to because of the following informalities: line 3; delete "a respective" and insert --said respective--. Appropriate correction is required.

### ***Drawings***

2. Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

Art Unit: 3765

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 13 recites a "minimum depth of less than 8 mm". Thus, this recitation would include all depth values less than 8 mm as well as all depth values greater than 8 mm. This is indefinite because the minimum depth value cannot be ascertained. Claim 14 recites "minimum depth of about 5.75 mm or less". Similarly, claim 14 recites a depth value of about 5.75 mm or all values less than 5.75 mm. This is indefinite because as outlined above, claim 13 could be interpreted as having a depth value greater than 8 mm, while claim 14 defines the depth value as 5.75 mm or less.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-17 and 54-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Banks (U.S. 6,131,208). Banks discloses the invention as claimed. Banks teaches swim goggles comprising a pair of unconnected eyepieces, each eyepiece comprising a transparent lens 3 and frame, body portion or peripheral flange 1 surrounding the lens and having a posterior surface. The flange is sized and shaped to fit at least partially within a respective orbital rim and the lens portion positioned in front of an eye when the eyepiece is worn. The flange also includes an upper nasal portion and a lower nasal portion on an inner side that fit within a respective orbital rim and also includes a lower temporal portion on an opposing side that fits at least partially within a respective orbital rim. Each eyepiece is adapted to provide a water-tight seal around an eye of a user during use of the goggles, wherein each eyepiece has a minimum depth about 5.75 mm or less, or of less than 8 mm measured at locations above and below the eyes when the eyepieces are in an as worn orientation. The recitation of "a minimum depth of less than 8 mm measured at locations.....in an as worn orientation" is functional in that it does not recite the structural dimensions of any specific portion of the eyepiece. It is noted that pages 10-11 of Applicant's specification discuss the depth of the eyepieces as measured from the inner surface of the anterior lens and the temporal end of the anterior lens. As currently presented, claim 13 conveys that the depth of the eyepiece is determined by the dimensions of the wearer's eye as well as by the positioning of the eyepiece in relation to the wearer's eye portions. For example, if the eye socket or orbital bones are deeper-set, then the depth of the eyepiece will likely be smaller when measured at locations above and below the eyes. Banks is silent with

Art Unit: 3765

regard to the depth of the frame portion, but the domed shape of the frame fits over a wearer's eye and appears to have a minimum depth of less than 8 mm measured at locations above and below the eyes when the eyepiece are in an as worn orientation. That is, the domed shape allows for covering the eyes without interfering with the wearer's eye blinking capabilities. Each eyepiece includes a layer of adhesive tape 5 for adhesively securing the eyepiece to the skin. Each layer of tape comprises a deformable layer that is secured to the posterior surface 4 of a respective frame and has an adhesive surface for adhering to the skin. The eyepieces can be retained in place by contracting the orbicularis oculi muscles against the frame portions.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 33-35, 37, 38, and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen-Lieh (U.S. 6,341,863). Chien-Lieh discloses the invention substantially as claimed. Chen-Lieh teaches an eyepiece for swim goggles comprising a body 40 adapted to be worn over the eye of a user and form a water-tight seal around the eye that isolates the eye from the surrounding environment during use, the body comprising a transparent lens portion that includes a first, flat anterior lens 21 positioned in front of the eye in an as worn orientation and at least a second, flat lens 22

Art Unit: 3765

comprising flat and parallel opposed surfaces. The second lens is connected to the anterior lens at an obtuse angle and extending rearwardly therefrom, wherein the second lens reduces prismatic distortion of the lens portion and is connected to the anterior lens at an angle of less than 180 degrees as shown in Figure 3, which illustrates the obtuse angular relationship. Each eyepiece comprises an annular side wall 11 surrounding a respective anterior lens and side lens and extending rearwardly therefrom. A posterior frame portion 30,31 is connected to a respective side wall opposite the anterior lens and side lens, the frame portion being shaped to form a water-tight seal around an eye. The goggles include a nose piece (not labeled but shown in Figure 1) connecting adjacent nasal end portions of the eyepieces as shown in Figure 5 and a head strap (not labeled) connected to respective temporal end portions of the eyepieces and dimensioned to extend around the rear of the user's head. However, Chen-Lieh doesn't teach the angle is approximately 124 to 164 degrees or about 144 degrees. Chen-Lieh teaches that the angle of less than 180 degrees allows for improved field of vision between the flat lens in front of the eye, and the side lenses. Applicant's specification does not provide the criticality for the obtuse angle in the claimed range. Thus, a preferred range for the angle between the first and second lenses could have been arrived at through routine experimentation. Therefore, it would have been obvious to provide Chen-Lieh's first and second lenses with an angle therebetween of approximately 124 to 164, or 144 degrees such that an optimal field of view and clear vision is achieved and maintained. Since the modified lens orientation of Chen-Lieh discloses the claimed structure, the resulting lens is expected to perform in

the same way as recited by claim 37, which states that the second lens reduces hydrodynamic drag of the eyepiece and prismatic distortion of the lens portion such that whenever the eye is rotated temporally to a position at which the visual axis intersects a midpoint of the side lens, a line of sight extends perpendicularly with respect to the side lens. Further, the side lens is oriented with respect to the anterior lens such that a line of sight along the visual axis intersects the side lens at 90 degrees whenever the eye is rotated to a temporal position at which the visual axis intersects the side lens and the line of sight extends through a midpoint of the side lens.

#### ***Allowable Subject Matter***

9. Claims 18 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 36 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.



Art Unit: 3765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch, may be reached at (571) 272-4996. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 26, 2007



Katherine Moran

Primary Examiner, AU 3765